

**ATTORNEY DOCKET NO.: 0492611-0315 (MIT 6196)**

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Applicant: Griffith-Cima, et al. Examiner: D. Naff  
Serial No.: 09/008,945 Art Unit: 1651  
Filed: January 20, 1998  
For: TISSUE FORMATION BY INJECTING A CELL-POLYMERIC SOLUTION  
THAT GELS IN VIVO

Commissioner of Patents  
Washington, DC 20231

Sir:

**DECLARATION UNDER 37 C.F.R. 1.132**

We, Anthony Atala, Linda G. Griffith, Charles A. Vacanti, and Keith T. Paige declare as follows:

1. We are the inventors of the subject matter disclosed and claimed in United States patent application Serial No.09/008,945 ('945 application) filed January 20, 1998 and entitled "TISSUE FORMATION BY INJECTING A CELL-POLYMERIC SOLUTION THAT GELS IN VIVO". This application claims priority to United States patent application Serial No. 08/056,140 now issued U.S. Patent No. 5,709,854, by Griffith-Cima et al. entitled "Tissue Formation by Injecting a Cell-Polymeric Solution that Gels In Vivo", filed on April 30, 1993.
  
2. This Declaration is presented for the purpose of removing from consideration by the Examiner an abstract by Atala et al., entitled "Cartilage Cells as a Potential Treatment for Reflux", American Academy of Pediatrics, 1992 Annual Meeting, Section on Urology Program for Scientific Sessions, San Francisco, CA, Saturday, October 10-12, (1992) (Reference "R"). The conference began on October 10, 1992, at which time the above-referenced abstract was

available to the public in this country. The present Declaration is presented in accordance with *Ex Parte Magner*, 133 USPQ 404 (CCPA 1961) and *In re Katz*, 455,215 USPQ 14, 18 (CCPA 1982) and establishes that the allegedly anticipatory material in Reference R was not invented by another.

3. Charles Vacanti and Anthony Atala are two of the inventors on the instant application and are also two of the co-authors of Reference R.

4. Alan B. Retik is the third co-author of Reference R. Dr. Retik is not an inventor of the claimed invention and did not make an inventive contribution to the subject matter of Reference R. Dr. Retik was working under the direction of Dr. Atala when he participated in the research which was described in Reference R.

5. Linda G. Griffith, Charles A. Vacanti, Keith T. Paige, and Anthony Atala mutually conceived and reduced to practice the invention recited in the claims of the '945 application. Dr. Griffith has changed her name from Griffith-Cima since the parent application was filed.

6. All statements made herein of our own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful, false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful, false statements may jeopardize the validity of the application or any patents issued thereon.

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Anthony Atala, M.D.

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Date

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Linda Griffith, Ph.D.

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Date

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Charles A. Vacanti, M.D.

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Date

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Keith T. Paige, M.D.

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Date

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rejection of the appealed claims as indefinite and failing to point out the invention. [4] The lengthy petition, in effect, merely expresses disagreement with our view that in the particular circumstances in this case the examiner was correct in holding that the product should be defined by the process of making it. We have carefully considered the petition but are not persuaded thereby that our decision is in error. In respect to the petitions which petitioners call to our attention, we point out that what was done during the prosecution of other applications for patent is not controlling here.

The petition has been considered but is denied in respect to making any change in our decision.

**Particular Patent—Preparing Uranous Tetrafluoride**

Application for patent of James E. Mager, Ray S. Long, David A. Ellis, and Robert R. Grinstead, Serial No. 3,030,175, "Preparation of High Purity Urano," claim 13 of application allowed.

**Appeal from Division 46.**

Application for patent of James E. Mager, Ray S. Long, David A. Ellis, and Robert R. Grinstead, Serial No. 675,604, filed July 31, 1957. From decision rejecting claim 13, applicants appeal. Reversed.

Before AER, Examiner in Chief, and BEHRENS and GAFSON, Acting Examiners in Chief.

**GASTON, Acting Examiner in Chief.**

This is an appeal from the final rejection of claim 13 the only claim in the case.

Claim 13 is as follows:

13. In a process for preparing highly pure uranous tetrafluoride from impure uranium laden solvent extraction process strip solutions and ion exchange process and resin-in-pulp process eluate solutions which are at least 8M in hydrochloric acid, the steps comprising treating said solution with a reducing agent thereby reducing the uranium in said solution to the +4 oxidation state, contacting the solution with an extractant phase comprising about 10 to 70% of kubity phosphate in an organic solvent-diluent selected from the group consisting of benzene, ethyl-benzene, chlorobenzene, toluene, xylylene, kerosene and carbon tetrachloride to extract the uranium therefrom, treating the extract phase with an aqueous fluorite solution to precipitate uranous tetrafluoride therefrom, and separating the uranous tetrafluoride from the phases."

The reference relied on is:

AEC Document DOW-147, Sept. 1, 1956, pp. 8-11

**Patent Office Board of Appeals**

**Ex parte MAGNER, LONG, ELLIS, AND GRINSTEAD**

Patent issued Apr. 17, 1962  
Opinion dated Oct. 25, 1961

#### PATENTS

##### 1. Affidavits — Anticipating references (§ 12.3)

**Interference — Originality of invention—in general (§ 41.551)**

**Patentability — Anticipation—Publications—in general (§ 51.221)**

Publication by three of four inventors of instant application, published less than a year before application filing date, is removed as reference by such three inventors' affidavit wherein state that they are authors of publication, that they are three of four co-inventors; explanatory affidavit by fourth co-inventor is unnecessary; affidavit under Rule 131 is unnecessary since no question of priority is involved; affidavit sufficiently explains relation of publication to application; any competent evidence convincing to Patent Office may be accepted on question of originality.

Claim 13 stands rejected by the examiner as unpatentable over the DOW-147 publication.

[1] The sole issue in this case is the procedure necessary for removing as a reference DOW-147 as publication by three of the four inventors of this application, published less than a year before the application filing date.

FEB. 13, 2001  
AMERICAN BEAUTY PLEAT, INC.  
JUDKINS COMPANY; JUDKINS  
COMPANY V. AMERICAN  
BEAUTY PLEAT, INC.

Decided Mar. 6, 1982

#### TRADEMARKS

6:38PM  
Identity and similarity — Word CHOATE  
Similar (§ 67.411)  
"Glamor Fold" so resembles "Re-M  
Fold" as to be likely to cause confust  
in trade.

2. Identity and similarity—How determined—In general (§ 67.4051)  
Differences between decolcomania labels on which parties apply their marks are immaterial and irrelevant in the determination of applicant's right to register its mark.

3. Cancellation—Abandoned mark (§ 1713)  
Since opposer's use of its registered mark was prior to applicant's use of mark, and since confusion is likely, marketing of goods under these marks is clear that applicant, at time of petition to cancel, opposer's registration, did not possess any right to its mark; which it could assert against the opposer; accordingly, opposer's registration is now inconsistent with its mark; hence, question whether registered mark has been abandoned can of no concern to applicant.

4. Abandonment—In general (§ 67.03)  
Assignor of trademark was user of trademark prior to and at time of assignment; fact that assignor's sales do not constitute an abandonment of mark at that time were small to none a basis for cancellation of registration; although assignee never sold act article upon which assignor used mark, it has used mark since assignee on goods intended for similar use, which could originate from same source as assignor's goods; thus, assignee's use of mark cannot constitute abandonment by it of registered mark.

Trademark opposition No. 39,718  
American Beauty Pleat, Inc., again  
Judkins Company, application, Ser  
No. 82,238, filed Sept. 25, 1959. Opp  
tion sustained.  
Trademark cancellation No. 7,467  
Judkins Company against Ameri

efficient? *Lindstrom v. Ames*, 37 App. D.C. 15, 1911 C.D. 384 (1911) (proof of actual reduction to practice negates having to rely on one's filing date for constructive reduction to practice by filing patent application). See also *Sistar v. Farmer*, 1883 D. 34, 23 O.G. 2325 (*Sec'y Int.* 1883), wherein it was held that actual reduction to practice may be better evidence of invention than an application but that "until that evidence [the application] is overthrown," id. at 1, the applicant need do more than rely on his application filing date.

In any event, I would remand for determination of Daugherty's right to rely on the date of their application as their priority date for a determination of priority based on the evidence of Daugherty's actual reduction to practice.

#### Inference — Reduction to Practice — Constructive reduction (§41.755)

Unlike filing of patent application, publication of article is not constructive reduction to practice of subject matter described in it; therefore, disclosure in publication does not prove that any "invention" within meaning of Section 102(g) has ever been made by anyone.

#### 4. Patentability — Anticipation — Patents

##### — In general (§51.221)

#### Patentability — Anticipation — Publications — In general (§51.221)

Interpretation of Section 102(a) that would make prior patent or printed publication "prior art" even though disclosure is that of applicant's own work would negate one year period afforded under Section 102(b) during which inventor is allowed to perfect, develop, and apply for patent on his invention and publish descriptions of it if he wishes.

#### 5. Patentability — Anticipation — In general (§51.201)

One's own work is not prior art under Section 102(a) even though it has been disclosed to public in manner or form that otherwise would fall under Section 102(a); disclosure to public of one's own work constitutes bar to grant of patent claiming subject matter so disclosed, or subject matter obvious from it, only when disclosure occurred more than one year prior to application's date, that is, when disclosure creates one-year time bar, to application under Section 102(b); one's own invention, whatever form of disclosure to public, may not be prior art against oneself, absent statutory bar.

#### 6. Patentability — Anticipation — Publications — In general (§51.221)

Disclosure of publication that occurred less than one year before applicant's application comes within scope of Section 102(a) only if description is not of applicant's own work.

#### 7. Patentability — Anticipation — Publications — In general (§51.221)

As noted in *Tate v. Wintell*, supra at 61, 209 USPQ at 382 n. 10, only abandonment, suppression or concealment of the invention are grounds under §102(g) for awarding priority to June 16 to the party who is not the first inventor *de facto*. Thus, I disapprove of the view expressed by the board in *Isagro v. Peizer*, 212 USPQ 838, 845 (BOP 1981) (no Petition for Rehearing).

A party to an interference who has not complied with the "best mode" requirement of the statute has "no right to make" his claims corresponding to the counts and, therefore, is not entitled to an award of priority, irrespective of testimony as to inventive acts.

from fact of co-authorship; on other hand, when PTO is aware of printed publication that describes subject matter of claimed invention and is published before application is filed (only date of invention on which it must act in absence of other proof), article may or may not raise substantial question whether applicant is inventer; for example, if author, whether he is applicant or not, specifically states that he is describing applicant's work, no question at all is raised; content and nature of printed publication, as well as circumstances surrounding its publication, not merely its authorship, must be considered.

#### 8. Patentability — Anticipation — Publications — In general (§51.221)

Although submission of disclaiming affidavits or declarations by other authors of article that does not tell anything specific about inventorship and that reports on scientific work in which applicant and other authors have been engaged in some capacity would have ended inquiry into whether it can be reasonably concluded that applicant is sole inventor, they are not required by statute or Rule 132; what is required is reasonable showing supporting basis for applicant's position.

#### 9. Applicants for patent — In general (§41.1)

#### Patentability — Anticipation — Publications — In general (§51.221)

Joint inventorship cannot be inferred, in face of sworn statements to contrary, from article authored by applicant and students working under applicant's direction and supervision.

Particular patents — Immunological Tolerance Induction Katz, Induction of Immunological Tolerance, rejection of claims 1, 5, 17, and 18 reversed.

Appeal from Patent and Trademark Office Board of Appeals.

Application for patent of David Harvey Katz, Serial No. 937,574, division of application, Serial No. 764,586, filed Feb. 3, 1977. From decision rejecting claims 1, 5, 17, and 18, applicant appeals. Reversed; Miller, Judge, dissenting with opinion.

John H. Lynn and Gran L. Hubbard, both of *National Research Council*, for appellants.

Joseph F. Nakanura and Gerald H. Bjor, for Patent and Trademark Office.

Markley, Chief Judge, and Rich, Baldwin, Miller, and Nies, Associate Judges.

Nies, Judge.

This appeal is from the decision of the Patent and Trademark Office (PTO) Board of Appeals (board) sustaining rejection of claims 1, 5, 17, and 18, all remaining claim 39 in application Serial No. 937,574 for "Induction of Immunological Tolerance." The subject application is a divisional application of application Serial No. 764,586, filed February 3, 1977, and is entitled to that filing date.

The claims were rejected because of a description of the subject matter of the invention in a publication dated June 1976, while appellant, however, asserts is a description of his own work. The board was unsuaded by appellant's declarations to the effect and sustained the rejection. We reverse & remand.

*Background*

STEWART 723-23-7881  
In June, 1976, eight months before applicant's effective filing date, an article coauthored by Nicholas Chiorazzi, Zelig Eshkol and appellant was published in the Proceedings of the National Academy of Sciences U.S.A., Vol. 73, No. 6, pp. 2091-95. There is no dispute that the article (Chiorazzi et al.) fully describes the claimed invention.

Along with his divisional application, appellant filed a declaration in which he declared that:

He is the sole inventor of the subject matter described and claimed in the United States Patent Application Serial No. 764,586, filed February 3, 1977, entitled, INDUCTION OF IMMUNOLOGICAL TOLERANCE, which subject matter is disclosed and claimed in part in the divisional application with which this application is submitted.

He is co-author of a report in the proceedings of the National Academy of Sciences, U.S.A., Volume 73, No. 6, Page 2091-2095, June, 1976, communicated to the National Academy of Science by Albert H. Coons, a member of said Academy, on March 8, 1976, that he is the sole inventor of the subject matter which is disclosed in said publication in the proceedings of the National Academy of Science and disclosed and claimed in the application submitted.

[6] Since the publication in this case occurred less than one year before appellant's application, the disclosure comes "within the scope of §102(a) only if the description is not of appellant's own work."

The specific question present in this appeal is essentially an evidentiary one, namely, the sufficiency of applicant's showing to establish that the subject disclosure was his original work, and his alone. We conclude that applicant's declaration is sufficient in this case to overcome the rejection.

[7] As an initial matter, we hold that authorship of an article by itself does not raise a presumption of inventorship with respect to the subject matter disclosed in the article. Thus, co-authors may not be presumed to be co-inventors merely from the fact of co-authorship. On the other hand, when the PTO is aware of a printed publication which describes the subject matter of the claimed invention and is published before an application is filed (the only date of invention on which it must act in the absence of other proof), the article may or may not raise a substantial question whether the applicant is the inventor. For example, if the author (whether he is the applicant or not) specifically states that he is describing the work of the applicant, no question at all is raised. The content and nature of the printed publication, as well as the circumstances surrounding its publication, not merely its authorship, must be considered.

What we have in this case is ambiguity created by the printed publication. The article does not tell us anything specific about inventorship, and appellant is only one of three authors who are reporting on scientific work in which they have all been engaged in some capacity at the Harvard Medical School. It was incumbent, therefore, on appellant to provide a satisfactory showing which would lead to a reasonable conclusion that he is the sole inventor.

[8] The board and the examiner held that "disclaiming affidavits or declarations by the other authors are required to support appellant's position that he is, in fact, the sole inventor of the subject matter described in the article and claimed herein." This was clear error. Submission of such affidavits or declarations would have ended the inquiry, but we do not agree that they are required by the statute or Rule 132. What is required is a reasonable showing supporting the basis for the applicant's position.

In this case, appellant reaverred in his declaration that he is the sole inventor of the subject matter described and claimed in his application and also that disclosed in the publication of proceedings of the National Academy of Science. We do not view this averment as a mere pro forma restatement of the oath in his application.

[9] In the declaration, appellant provides the explanation that the co-authors of the publication, Chiorazzi and Eshhar, "were students working under the direction and supervision of the inventor, Dr. David H. Katz." This statement is of significance since it provides a clear alternative conclusion to the board's inference that their names were on the article because they were co-inventors. As acknowledged by the examiner, the names of individuals may be given as authors of a scientific report who are "involved only with assay and testing features of the invention."

Appellant's explanation is, thus, consistent not only with the content of the article but with the nature of the publication. On the record here, the board should not have engaged in further speculation as to whether appellant's view was shared by his co-authors but rather should have accepted that Chiorazzi and Eshhar were acting in the capacity indicated, that is, students working under the direction and supervision of appellant. From such a relationship, joint inventorship cannot be inferred in the face of sworn statements to the contrary.

Thus, we conclude that in view of the totality of circumstances, appellant has made a sufficient showing that the cited publication discloses his invention. Accordingly, we reverse the decision of the board.

*Reversed.*

Miller, Judge, dissenting.

The board correctly held that it is reasonable showing can be made under Rule 132, 37 CFR 1.132, which provides:

"Such showing can be made under Rule 132, 37 CFR 1.132, which provides: When any claim of an application is rejected on reference to a \* \* \* printed publication \* \* \* affidavits or declarations traversing [the reference] \* \* \* may be received.

"The solicitor notes that in the application, there is an inconsistency in that the subject application and its parent by a sole inventor refer to previous work done by "one of the inventors." While adding to the ambiguity, this statement, which applicant's attorney represents was his error in draftsmanship,

ship. This inference is sufficient to justify a determination by the PTO that the reference printed publication ("Chiorazzi et al.") in question is prior art under 35 USC 102 as applied against an application for patent filed by one of the coauthors. In re Facius, 56 CCPA 1348, 408 F.2d 1396, 161 USPQ 294 (1968); In re Mathews, 56 CCPA 1035, 408 F.2d 1393, 161 USPQ 276 (1969); In re Land, 54 CCPA 806, 368 F.2d 866, 151 USPQ 621 (1966). Although all of the latter opinions by this court have involved prior patents issued to different inventive entities, the board has established a line of cases involving only printed publications. In re Magnet, 133 USPQ 404 (1961); In re Seaborg, 131 USPQ 202 (1960); In re Hirschler, 110 USPQ 384 (1952); In re Layne, 63 USPQ 17 (1943). Such cases are analogous to the instant appeal, and, contrary to appellant's arguments, are consistent.

In Layne, the board agreed with the examiner that an affidavit by the applicant, stating that an article, published by another was made with the applicant's consent, was not sufficient to overcome the examiner's rejection. The board stated:

"It is stated in the brief that counsel can obtain an affidavit of the writer of the article in the publication that he obtained his information from the defendant. It is our view that this affidavit of the writer of the article, H. Lee Flood, should be furnished to afford complete and satisfactory proof of the identity of the article disclosed in the publication.

"Until the affidavit referred to is furnished, the rejection on the publication in the Petroleum Engineer appears proper.

\* \* \* Until the affidavit, this printed publication is also evidence that "the invention was known or used by others in this country \* \* \* or described in a printed publication in this \* \* \* country, before the invention thereof by applicant" under 35 USC 102(a) and, as held by the examiner, is evidence that "before the applicant's invention thereto the invention was made in this country by another" under 35 USC 102(g). The "others" in 102(a), "not himself" in 102(l), and "another" in 102(g) are terms that serve to distinguish between different inventive entities. Contrary to the majority opinion's view of section 102(g), the Katz et al. article indicates that the invention was actually reduced to practice; applicant did not invent, the examiner's rejection on this basis. In this case, Katz, the applicant, is one inventive entity and his effective date of invention, as the record now stands, is his application filing date. Collectively, Katz, Chiorazzi, and Eshhar comprise a second inventive entity. See

On the question of originality any affidavit concerning to the Office may be accepted. The evidence here is in the form of an affidavit by joint author Wahl stating that he is not the inventor of the subject-matter claimed herein. In absence of a witness of interest there seems to be little basis for challenging this affidavit. In fact, the examiner states on page 4 of his answer that he "has no doubt that Seaborg is the sole inventor of the subject-matter claimed

For this reason, the rejection is affirmed. It is recommended, however, that if a prior art affidavit of H. Lee Flood is promptly filed, the claims be allowed.

[6] USPQ, at 19. Layne differs from Layne present case in that the inventor in Layne was not named as a coauthor; here, Katz was one of the named coauthors.

When presented with an examiner's r 40 PM application utilizing a publication coauthored by applicant and his laboratory assistant, CHOATE Hirschler refused to sustain the rejection in view of the submission of affidavit disclaiming inventorship which was executed by the lab assistant. The board [A] affidavit which points out that the applicant took no part in writing the article and not the invention of the subject matter Hall described in the article, but was merely [as coauthor of the article in order to reference credit for having collaborated on the rejection affidavit filed by the inventors sent, \* \* \* the article may be considered the work of present applicant. Since the artwork is not a statutory bar, it is not effective reference.

[110 USPQ, at 387. Here, of course, there is no disclaiming affidavit filed by the inventors and alleged coinventors.

Appellant quotes the following statement the board in Seaborg explaining that a 131 affidavit was unnecessary:

The issue is not one of priority but attribution of inventorship, the examiner evidently having in mind the possibility that Wahl might be a joint inventor. But we would emphasize that the bare fact that Wahl the literary co-author is not evidence joint inventorship.

[131 USPQ, at 203. This statement is 14 out of context, the board actually conclu-